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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/273,261	03/22/1999	TAKUMA HATTORI	755-TM546	6894

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WENDEROTH LIND & PONACK  
2033 K STREET N W  
SUITE 800  
WASHINGTON, DC 20006

EXAMINER

NGUYEN, DUNG T

ART UNIT

PAPER NUMBER

2871

DATE MAILED: 05/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/273,261

Applicant(s)  
Hattori et al.

Examiner  
Dung Nguyen

Art Unit  
2871



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Feb 10, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-11 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on Feb 10, 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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*Response to Amendment*

Applicant's amendment dated 02/10/2003 has been received and entered.

Applicant's arguments have been considered but are moot in view of the new grounds of rejection.

*Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371 © of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1, 3-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Inoue et al., US Patent No. 5,786,042.

The above claims are anticipated by Inoue et al. ('042) which disclose an attachment film (resin black matrix) for an electronic display (liquid crystal display device) comprising an adhesive

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layer in which carbon black having a pH of 4 or less (col. 7, ln. 31) and a diameter of 30nm (col. 8, ln. 6) dispersed therein and an acrylic adhesive having a carboxyl group and/or a hydroxyl group (col. 7, ln 42+) formed on a substrate (col. 11, ln. 41). In addition, the adhesive layer further contains a coloring pigment different from the carbon black (e.g., blue pigment)(col. 8, ln. 26).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue et al., US Patent No. 5,786,042, in view of Aoyama et al., US Patent No.6,147,732..

Regarding claim 2, Inoue et al. disclose the claimed invention as described above except for an anti-reflection layer formed on the side of the substrate. Aoyama et al. disclose in Fig. 38 that the adhesive layer (12) is formed on one surface of a transparent substrate (25) and an anti-reflecting layer (15) are formed on the other surface of the transparent substrate. Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to employ an anti-reflecting layer being formed on the other surface of the transparent substrate, for the ease to see the display image (col. 18, ln. 67).

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5. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue et al., US Patent No. 5,786,042, in view of Kawazu et al., US Patent No. 5,876,854.

Regarding claims 5-6, Inoue et al. disclose all claimed subject matter except the attachment film being colored in neutral gray. Kawazu et al. disclose the attachment film being colored in neutral gray. The a-value and b-value of neutral gray which are within  $\pm 5$  each when measured with a color different meter to reduce the dazzle caused by reflection and in order to assure correct color of displayed image (column 3 lines 15-34). Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to make attachment film having color in neutral gray; and neutral gray having an a-value and b-value are within  $\pm 5$  to reduce the dazzle caused by reflection and in order to assure correct color of displayed image.

6. Claims 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue et al., US Patent No. 5,786,042, in view of Baker et al., US Patent No. 5,200,477.

Regarding claim 7, Inoue et al. disclose the claimed invention as described above except for a BET specific surface area. Baker et al. do disclose that a carbon black having a specific surface area of from 30 to 1,500 m<sup>2</sup>/g can be formed in the adhesive layer. Thus, such disclosed range in Baker et al. makes possible the claimed range and overlapping ranges are at least obvious. See *In re Malagari*, 499 Fed.2d 1297, 182 USPQ 549 CCPA 1974.

7. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue et al., US Patent No. 5,786,042, in view of Urano et al., US Patent No. 5,800,952.

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Regarding claims, Inoue et al. disclose all claimed subject matter except that the adhesive layer further contains a photopolymerizable compound and a photo polymerization initiator. The adhesive layer contains a (meth) acrylate resin as an adhesive and a (meth) acrylate monomer or oligomer as photopolymerizable compound. Urano et al. disclose the adhesive layer further contains a photopolymerizable compound and a photo polymerization initiator to improve the developability, the sensitivity, the image-reproducing property and the adhesive property. The organic binder polymer material may, for example, be an alkyl ester which may have a substituent, of (meth) acrylate) and alkali-solute polymer comprising a monomer having (meth) acrylic acid monomer or photopolymerizable compound to develop with alkali aqueous solution but not with organic solvent (column 2 lines 12-41 and Column 7 lines 17-36). Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have adhesive layer containing a photopolymerizable compound, a photo polymerization initiator, (meth) acrylate resin to improve the developability, the sensitivity, the image-reproducing property and the adhesive property.

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue et al., US Patent No. 5,786,042, in view of Urano et al., US Patent No. 5,800,952, further in view of Aoyama et al., US Patent No.6,147,732.

Regarding claim 11, Inoue et al., as applied in prior rejection, disclose all claimed subject matter except for a hard coating layer and an anti-reflecting layer being consecutively formed on the other surface of a transparent substrate. Aoyama et al. disclose in Fig. 38 that the adhesive

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layer (12) is formed on one surface of a transparent substrate (25) and a hard coating layer (10) and an anti-reflecting layer (15) are consecutively formed on the other surface of the transparent substrate. It is noted that the materials of hard coating layer (10) of Aoyama et al. (col. 7, lines 26-34) are the same materials as those of applicant (page 7 of specification, lines 4-6, i.e. acrylic resin). Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to employ adhesive layer being formed on one surface of a transparent substrate. Furthermore, a hard coating layer and an anti-reflecting layer being consecutively formed on the other surface of the transparent substrate, for the ease to see the display image (col 18, ln. 67).

### *Conclusion*

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,


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will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Dung Nguyen whose telephone number is (703) 305-0423. The fax phone number for this Group is (703) 308-7722.

Any information of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-0956.

DN  
05/02/2003

  
Primary Examiner  
T. Chowdhury